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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,888	05/07/2008	**Martin Wahlers Larsen**	36731-000028/US/NPB	5626

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EXAMINER	
BELCHER, HERMAN A	

ART UNIT	PAPER NUMBER
2448	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/594,888	LARSEN, MARTIN WAHLERS	
	Examiner	Art Unit	
	HERMAN BELCHER	2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/29/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to the application filed on 07/11/2008.

2. Claims 1-16 are pending.

3. Claims 1-16 are rejected.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 09/29/2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PA200400508, filed on 03/30/2004.

Specification

7. The disclosure is objected to because the foreign priority information was not included in the specification. The foreign priority information should be after the title of the disclosure. Appropriate correction is required.

Claim Objections

8. Claim 11 is objected to because of the following informality: Claim 11 recites the acronym "STMP" which should be spelled out. Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-4, 8-9, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) in view of Michael Voticky et al. (US Patent No. 6351764 B1, referred herein after Voticky).

As per claim 1, Drummond discloses a filter for filtering electronic messages, said filter comprising:

- storage space (e-mail server/anti-spamming agent, fig. 2, 200/210) **for an allowed** (approved) **list** (list) **comprising identification insignias** (addresses) **of senders which have been approved (**approved) **for sending messages to a recipient** (col. 4, lines 38-67, fig. 2),

- means (e-mail server) **for receiving** (received) **a first** (first time) **electronic message** (e-mail) **from a sender** (particular address) (col. 2, lines 25-36),

- means (e-mail server) **for capturing** (added) **from the message** (outbound e-mail) **an identification insignia** (address) **of the sender** (sent from the e-mail client) (col. 2, lines 37-41),

- means (e-mail server) **for capturing** (added) **from the message** (e-mail) **an identification insignia** (sending address) **of the recipient** (col. 3, lines 1-5),

- first check means (e-mail server) **for comparing** (determining) **the identification insignia** (sending address) **with the allowed list** (list of approved addresses) **for determining either to withhold the message** (holding queue) **or to forward** (released) **the message to the recipient** (cols. 2-3, lines 57-67, lines 1-5),

- means (e-mail server) **for storing** (stores) **the message and Insignia** (col. 4, lines 38-67, fig. 2),

- means (e-mail server) **for generating** (issued) **a return message** (email) **to the sender** (sending address) **in case the identification insignia** (address) **is not** (not) **included in the allowed list** (list of approved addresses) (col. 2, lines 57-67),

- the means (e-mail server) **for returning the message** (issuing an e-mail to the sending address) **being adapted to include In the returned message a unique code** (authorization code)**, and a message for the sender to reply to the returned message by sending it back without changing the unique code** (authorization code that must be included in any return acknowledgement) (col. 5, lines 7-33),

- means (e-mail server) **for storing** (stores) **the unique code and relating it to the insignia** (col. 4, lines 38-67, fig. 2),

second check means (e-mail server) **for receiving a second electronic message and for recognising the second message being a reply to the returned message** (cols. 2-3, lines 57-67, lines 1-5) where email is released from the holding queue upon receipt of the return acknowledgement,

characterised in that the filter further comprises:

- means (e-mail server) **for selecting** (added) **identification insignias** (sending address) **and adding** (added) **the selected insignias** (sending address) **to the allowed list** (list of approved addresses) (cols. 2-3, lines 57-67, lines 1-5).

Drummond does not specifically disclose characterised in that the filter further comprises: prioritising means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the first messages; wherein the means for selecting are adapted to carry out the selection according to the priorities assigned to the identification Insignias.

However, Voticky discloses characterised in that the filter further comprises:

- prioritising means which, in response to recognition of the second message being a reply to the returned message, assigns a priority to each of the identification insignias of the senders of the first messages (col. 3, lines 52-60)

where filter or discrimination mechanism for discarding or prioritizing e-mail messages can be maintained at the server,

- where the means for selecting are adapted to carry out the selection according to the priorities assigned to the identification insignias (col. 2, lines 28-44) where means for prioritizing the message is according to the data code.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Voticky's method of filtering and prioritizing messages to Drummond's method because this would reduce the number of unsolicited e-mail messages received by the recipient.

As per claim 2, Drummond discloses wherein the second check means performs the recognition by:

- capturing in the second message the unique code, and a second identification insignia of the sender of the second message, and checking that the unique code has not changed, and that the second identification Insignia corresponds to the first identification insignia (col. 5, lines 7-33) where authorization code must be included in any return acknowledgement for the return to be considered authentic.

As per claim 3, Drummond discloses further comprising means (e-mail client) **for capturing from a server a list comprising at least one address from which the sender has access to send messages from** (col. 2, lines 37-44) where a list of approved addresses is maintained at the e-mail server for each user and where the

address of any outbound e-mail sent from an e-mail client is automatically added to the user's approved address list (i.e. where user can access at least one address from the user's approved address list to send message).

As per claim 4, Drummond discloses further comprising means (e-mail server) **for checking that the sender is sending from an address included in the list** (col. 5, lines 7-33) where code set 216 is responsive to receipt of an email (for a given recipient) for determining whether the sending address of e-mail is on the recipient's given list of approved addresses.

As per claim 8, Drummond discloses wherein the identification insignias of the senders (sending address) **and the data identifying the sender Include at least a domain** (domain) **identification of the sender's electronic mail address** (col. 7, lines 7-38).

As per claim 9, Drummond discloses further comprising means (e-mail server) **for withholding the electronic message from final delivery to the intended recipient until an administrator** (administrator) **has accepted** (accept) **delivery of the message** (e-mail) **to the recipient, the administrator being one of a human administrator, a software-implemented administrator, and the recipient of the message** (col. 7, lines 7-38).

As per claim 14, Drummond discloses comprising means (e-mail server) **for measuring a frequency of messages to and from a specific sender, and upon detection of frequencies above a pre-specified level, for forwarding the first message to the recipient irrespective If the insignia of the sender is not in the allowed list** (col. 7, lines 31-38) where frequency of unsolicited e-mail can be monitored in order to determine an action (i.e. action could be to forward first message if detected frequencies is above a pre-specified level).

As per claim 15, Drummond discloses wherein the means (e-mail server) **for generating a return message to the sender is adapted to send the return message by use of an Identification insignia corresponding to the Identification Insignia of the intended recipient of the first message** (col. 4, lines 58-67) where an approved address represents a sending address which, although originally unrecognized, has been verified through a return acknowledgement.

Claim 16 corresponding to claim 1 and therefore rejected under the same reasons set forth in the rejection of claim 1.

11. Claims 5, 10, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) and Michael Voticky et al. (US Patent No. 6351764 B1, referred herein

after Voticky) in view of Roy Ben-Yoseph (US Patent No. 2004/0205127 A1, referred herein after Ben-Yoseph).

As per claim 5, Drummond and Voticky do not specifically disclose further comprising means for generating a predict allowed list comprising identification insignias of third party message recipients included by the sender In the first or the second electronic message.

However, Ben-Yoseph discloses further comprising means for generating a predict allowed list comprising identification insignias of third party message recipients included by the sender In the first or the second electronic message (pg. 3, pars. 0043) where if a person B (sender) is designated as someone user A (recipient) knows, then the people (third parties) designed as known to person B also may be designated as known to user A (recipient).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of sender, thirty parties, and recipient associations to generate a predict allowed list to Drummond's and Voticky's method because this would allow third party message recipients to be able to receive emails.

As per claim 10, Drummond and Voticky do not specifically disclose further comprising storage for a blacklist, and means for checking occurrence of an

identification insignia in the black-list prior to comparing the identification Insignia with the allowed list.

Howvever, Ben-Yoseph discloses further comprising

- storage for a blacklist, and means for checking occurrence of an identification insignia in the black-list prior to comparing the identification Insignia with the allowed list (pg. 4, par. 0055) where e-mail addresses are checked against blacklist in order to determine whether or not to they should be treated as spam and before the e-mail addresses are compared with the addresses on the allowed list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of checking the e-mail addresses against the blacklist first to Drummond's and Voticky's method because this would eliminate the blacklisted email addresses first, thus reducing the number of emails required for comparison.

As per claim 11, Drummond and Voticky do not specifically disclose comprising means for communicating, in an SMTP message, and In response to receiving the message from a sender with an insignia not included in the allowed list or optionally, with an Insignia Included In the black-list, that the message could not be delivered to the recipient .

However, Ben-Yoseph discloses comprising means for communicating, in an SMTP message, and In response to receiving the message from a sender with an insignia not included in the allowed list or optionally, with an insignia included in

the black-list, that the message could not be delivered to the recipient (pg 4, par. 0053) where blacklisted e-mails are treated as spam and are not shown to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of not showing blacklist email to user to Drummond's and Voticky's method because this would eliminate the number of unsolicited e-mails that are displayed to the user.

As per claim 13, Drummond and Voticky do not specifically disclose comprising means for adding to the allowed list, insignias of potential senders to whom the recipient has previously been sending Messages.

However, Ben-Yoseph discloses comprising means for adding to the allowed list, insignias of potential senders to whom the recipient has previously been sending Messages (pg. 3, pars. 0042 & 0045) where communication identifiers may be inferred as known if a message from that communication identifier is read, replied to, forwarded, saved, or printed and where inferred identifiers are added to the list.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Ben-Yoseph's method of adding inferred identifiers to list to Drummond's and Voticky's method because this would prevent e-mail addresses that are of interest to user but not on approved list to be received by the user and be added to the approved list.

12. Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk Drummond et al. (US Patent No. 6691156 B1, referred herein after Drummond) and Michael Voticky et al. (US Patent No. 6351764 B1, referred herein after Voticky) and Roy Ben-Yoseph (US Patent No. 2004/0205127 A1, referred herein after Ben-Yoseph) in view of William D. Cotten (US Patent No. 6330590 B1, referred herein after Cotten).

As per claim 12, Drummond, Voticky, and Ben-Yoseph do not specifically disclose comprising counting means for counting a number of reoccurrences of identical messages being received, and for adding the insignia of the sender of such messages which reoccur more than a pre-specified number of times to the black-list.

However, Cotten discloses comprising counting means (server) **for counting a number** (three) **of reoccurrences of identical** (identical) **messages** (messages) **being received** (detected), **and for adding the Insignia of the sender of such messages which reoccur more than a pre-specified number of times to the black-list** (where such message are eliminated i.e. insignia added to blacklist) (abstract, col. 3, lines 47-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention was made to incorporate the teaching of Cotten's method of eliminating identical messages that occur more than a pre-specified number of times to Drummond's, Voticky's, and Cotton's method because this would reduce the number of unsolicited e-mail messages received by the recipient.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form 892.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERMAN BELCHER whose telephone number is (571)270-7205. The examiner can normally be reached on Monday thru Thursday 7:30 AM thru 5:00 PM EST, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fermin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Herman A. Belcher Examiner, Art Unit 2448

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